

REMARKS

This Amendment is responsive to the Final Office Action mailed October 20, 2010. With this Amendment, claims 1, 4, 7, and 18 have been amended. Claims 1-26 are pending. Claims 4, 7, 10-11, and 18 are under consideration. Claims 1-3, 5, 6, 8, 9, 12-17, and 9-36 are withdrawn. No new matter has been added.

Entry of this Amendment after Final Rejection is appropriate because the amendments include claim language generally in accordance with that suggested in the Office Action of October 20, 2010. Entry of this Amendment after Final Rejection is also appropriate insofar as the Examiner indicated in a telephone call denying Applicants' request for an interview that advancement of prosecution of this application would be best accomplished in a written amendment.

Reconsideration and withdrawal of the rejections made in the above-referenced Office Action are respectfully requested in view of the foregoing amendments and the following remarks.

Requirement for Restriction

Claims 1-3, 5, 6, 8, 9, 12-17, and 19-36 are withdrawn as directed to non-elected subject matter. Applicants respectfully request that the Examiner reconsider the Requirement for Restriction, especially with regard to claim 1, and that the Examiner rejoin all of the withdrawn claims (or at least claim 1) at the Examiner's discretion. However, Applicants preserve their right to file one or more suitable continuation and/or divisional applications to the non-elected subject matter.

Information Disclosure Statement

Applicants thank the Examiner for acknowledging receipt of the Information Disclosure Statement filed August 6, 2010, and for indicating consideration of the same by including a signed copy of the Form PTO-1449 with the Office Action of October 20, 2010.

Statement of Interview

Applicants' representative, Walter Schlapkohl, thanks Supervisory Patent Examiner Rao for the courtesies extended during two telephone calls on January 20, 2011 and January 25, 2011.

During the January 20, 2011 telephone call, Applicants' representative informed SPE Rao that Applicants' request for a personal interview after Final Rejection had been denied. Applicants' representative further indicated that Applicants were requesting a personal interview to discuss, among other things, the priority claim of the instant application and the obviousness-type double patenting rejections of record. Applicants' representative further informed SPE Rao that Applicants' request for a personal interview had been denied because the Examiner believed prosecution of the instant application would be more efficiently advanced in a written, "after final" amendment. SPE Rao informed Applicants' representative that he would look into the matter.

In a follow-up telephone call on January 25, 2011, SPE Rao informed Applicants' representative that he had discussed Applicants' priority claim with the Examiner and that any confusion with regard thereto had been resolved. SPE Rao also indicated that the Examiner acknowledges the presence of an English language translation of PCT/JP04/18437, of which the instant Application is the National Stage, in the Image File Wrapper. In addition, SPE Rao further indicated that the Examiner believed that any remaining issues should be addressed in a written response to the Final Rejection rather than in an interview, and thus, Applicants' request for an interview at this stage of prosecution was denied.

Applicants submit herewith an Amendment in response to the Final Office Action in accordance with the Examiner's suggestion.

Claim Objections

The Office Action objects to claim 18 because it contains non-elected subject matter.

In response, Applicants submit that present Amendment addresses the instant claim objection. Accordingly, Applicants respectfully request reconsideration and withdrawal of the claim objection to claim 18.

Priority

The Office Action acknowledges Applicants' claim of foreign priority. However, the Office Action at page 4, lines 13-17, further asserts that the priority date of claims which recite features other than a nucleic acid encoding the polypeptide of SEQ ID NO: 1 is April 12, 2007 (the alleged filing date of the instant application). The Office Action also asserts that such claims are granted the benefit of priority only to April 12, 2007 “[i]n view of no certified English translation(s) of the International Application No. PCT/JP04/18437, Japan 2003-404472 and Japan 2004-018344” (Office Action at paragraph bridging pages 4-5).

In response, Applicants submit that their entitlement to foreign priority with respect to JP 2003-404472 and JP 2004-018344 is a formal matter, and depends solely upon whether the priority requirements under 35 U.S.C. § 119 have been satisfied. Applicants submit that they have. Applicants' foreign priority claim does not require that the Examiner review the foreign priority documents to determine whether they sufficiently disclose the subject matter of any claim. Accordingly, the Examiner's comments regarding the disclosures are not relevant to the formal claim of priority and its acknowledgement by the Office.

With regard to the assertion that a certified English translation of PCT/JP04/18437 has not been received, Applicants note that a Notice of Acceptance was mailed September 12, 2007 indicating receipt by the U.S. Patent and Trademark Office of an English translation of the international application on June 2, 2006. Applicants further submit that all of the filing requirements under 35 U.S.C. § 371, including the provision of an English translation of the PCT application, have been met. Accordingly, Applicants submit that the filing date for the instant National Stage Application is the filing date for PCT/JP04/18437, which is December 3, 2004 and not April 12, 2007 as the Office Action asserts.

Finally, Applicants have been assured that any confusion with respect to the Examiner's understanding of Applicants' priority claim has, in any event, now been resolved as summarized

in the Statement of Interview above. However, should any matter in this regard remain outstanding, Applicants invite the Examiner to contact the undersigned at the telephone number provided below.

Claim Rejections – 35 U.S.C. § 112, First Paragraph

The Office Action maintains the rejection of claims 4, 7, 10, 11, and 18 under 35 U.S.C. §112, first paragraph for allegedly failing to comply with the written description requirement. In particular, the Action states that recitation of the term “having” is equivalent to “comprising” and allows for additional mutations or changes in amino acids or nucleotides, and thus the claims are not limited to “1 to 20” amino acid changes or “1 to 60” nucleotide changes as recited. The rejection further suggests claim language to overcome the present rejection.

In response, Applicants have amended the claims to clarify the language noted by the Examiner in the Action. Applicants further submit that the claim language is generally in accordance with that suggested by the Examiner, although the claims remain directed, *inter alia*, to sequences in which up to 20 amino acids have been mutated by deletion, substitution, and/or addition, and not 10 amino acids as set forth in the Examiner’s proposed language. In this regard, the rationale provided in the written description rejection appears to be based upon the Examiner’s interpretation of the claims to encompass sequences having an unlimited number of amino acid deletions, substitutions, and/or additions, not 1 to 20.

In view of the above, Applicants submit that the instant Amendment clarifies the claims and respectfully request withdrawal of the rejection under 35 U.S.C. § 112, first paragraph.

Claim Rejections – 35 U.S.C. § 102

The Office Action maintains the rejection of claims 4, 7, 10, 11, and 18 under 35 U.S.C. §102(b) as allegedly anticipated by Timms-Wilson et al. (*Journal of Microbiological Methods* **46**:77-80, 2001).

Applicants respectfully disagree. In particular, Applicants submit that Timms-Wilson fails to teach or suggest, among other things, a “DNA encoding a fluorescent protein described in the following (a) or (b):

(a) a protein having the amino acid sequence shown in SEQ ID NO: 1; or

(b) a protein in the form of a monomer having the amino acid sequence shown in SEQ ID NO:1 except that 1 to 20 amino acids have been mutated by deletion, substitution and/or addition, which protein has fluorescence properties equivalent to the protein having the amino acid sequence shown in SEQ ID NO: 1.”

In view of the above, Applicants respectfully request reconsideration and withdrawal of the rejection under 35 U.S.C. § 102(b).

The Office Action also maintains the rejection of claims 4, 7, 10, 11 and 18 under 35 U.S.C. §102(b), or, in the alternative, under 102(a), as allegedly anticipated by Karasawa et al. (*Biochem J.* **381**:307-312, 2004).

In response, and as explained above, the effective filing date of the present application is December 3, 2004. As Karasawa et al. was published in 2004, it cannot qualify as a reference under 35 U.S.C. § 102(b). Applicants further note that Karasawa et al. was published after the filing date of Applicants' foreign priority applications, JP2003-404472 and JP2004-018344. Applicants further note that verified translations of JP 2003-404472 and JP 2004-018344 were provided with the response filed September 21, 2010. Applicants invite the Examiner to review the translations previously provided and determine their effect on the rejection over Karasawa et al. Applicants further invite the Examiner to contact the undersigned at the telephone number provided below in the event that one or more translations appear not to be present in the Image File Wrapper.

Obviousness-Type Double Patenting

The Office Action maintains the rejection of claims 4, 7, 10, 11, and 18 on the ground of nonstatutory obviousness-type double patenting as allegedly being unpatentable over claims 1-8 of U.S. Patent No. 7,541,451.

The Office Action also maintains the rejection of claims 4, 7, 10, 11, and 18 on the ground of nonstatutory obviousness-type double patenting as allegedly being unpatentable over claims 1-8 of U.S. Patent No. 7,226,993.

In response, Applicants submit that the instant rejections appear based in part on a claim interpretation in which the claimed subject matter includes DNA sequences which encode proteins having an unlimited number of deletions, substitutions, and/or additions. To the extent that the rejections have been based on this interpretation, Applicants submit that the present Amendment clarifies that issue and accordingly, overcomes the rejections.

However, to the extent that the present Amendment does not address the Examiner's concerns, Applicants request that the Examiner hold the obviousness-type double patenting rejections in abeyance until the claims are found free of the art and/or until such time as a personal interview may be scheduled to meaningfully address the rejection with color photographs or other evidence further distinguishing the claimed subject matter from that of the '451 and '993 patents.

In view of the foregoing remarks, Applicants respectfully submit that the claims of the present application are not obvious in view of any claims of U.S. Patent No. 7,541,451 or 7,226,993. Applicants therefore respectfully request withdrawal of the rejection. In the event that the obviousness-type double patenting rejections are not withdrawn, Applicants respectfully request that the Examiner hold the rejections in abeyance.

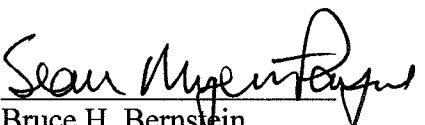
CONCLUSION

In view of the foregoing, the Examiner is respectfully requested to reconsider and withdraw the rejections of record, and allow all the pending claims.

No additional fee is believed due at this time. If, however, any additional fee is necessary to ensure consideration of the submitted materials, the Patent and Trademark Office is hereby authorized to charge the same to Deposit Account No. 19-0089.

Should there be any questions, the Examiner is invited to contact the undersigned at the below listed telephone number.

Respectfully Submitted,
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